

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----X)	
Exxon Mobil Corporation,)	
)	
Opposer,)	
)	
v.)	Mark: DEXXON
)	Opp. No.: 91,120,519
)	Serial No.: 75/511,805
DataWorx, B.V.,)	
)	
Applicant.)	
-----X)	



12-15-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

APPLICANT'S RESPONSE TO
OPPOSER'S MOTION FOR SUMMARY JUDGMENT

The Applicant, DataWorx BV responds to Opposer's motion for a Summary Judgment and respectfully moves the Board to deny such motion.

The Opposer sets forth the novel proposition that Congress has established some intent to use practice dubbed by Opposer as "Token Intent to Use". Opposer then proceeds to attack this straw man. Unfortunately, for Opposer, there is no presently cognizable issue of such intent. Rather, Congress has established an intent to use standard as prerequisite for filing an application

for trademark protection in the United States. The Applicant has sworn to its *bona fide* intent to use its mark. Such *bona fide* intent has been exhibited through various means, and various documents. Opposer would appear to be attacking the core of the intent to use application system, and trying to return the Board to pre-1989 standards which required actual use of a mark in commerce to qualify for registration. (Parenthetically, the Applicant notes that even under the pre-TLRA standards, the owner of a valid trademark registration in its country of origin was entitled to registration in the United States; TLRA now requires owners of foreign registrations to also possess a *bona fide* intention, however).

Indeed the Opposer seems to be demanding proof from the Applicant that the mark already has been used in commerce, a requirement which is non-existent. Congress allowed for applicants to seek registration of those marks in which they have a *bona fide* interest.

It is undisputed that the Applicant has already conducted business under the DEXXON name and mark for many years. It is equally undisputed that the

Applicant, like many companies, would have a *bona fide* intent to use its mark in the largest free-market economy in the world. Further, by its institution of this opposition procedure, the Opposer has shown it would rather the applicant not be permitted to use this trademark in the United States. None of these factors support a conclusion that the Applicant, therefore, must have lacked *bona fide* intent to use the mark in commerce. The criteria of such *bona fide* intent, as has often been pointed out, was not articulated by Congress for good reason. Companies large and small often develop an idea for a trademark in an instant and immediately seek to lock in their rights, before third parties can adopt the same or similar trademark. Documentary evidence would not exist at such a time, but the owners intent cannot reasonably be in dispute. Congress further granted applicants a very long period of time following allowance before needing to prove use. Congress further recognized the desirability of allowing companies to develop marks and, in a system shared by most other countries, to permit users to lay claim to a trademark before actual use. Recognizing that the time period from filing to proof of use under almost any circumstances will well exceed four years, Congress cannot be said to have contemplated the types of

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obstacles for proving the applicants "*bona fide* intent" that the Opposer claims exist.

This Board has held that *bona fide* intent is a very fact-specific inquiry. The Board has discussed a number of various factors which can be considered. Such factors would include evidence of abuse of the system, such as where an applicant has a history of filing numerous trademark applications, none of which ever matured into registration, and none of which marks ever were used (see: Lane Limited v. Jackson International Trading Company et al, 33 USPQ2d 1351, 1355 TTAB 1993.)

The Board has further stated that "as general rule, the factual question of intent is particularly unsuited to disposition on summary judgment." Commodore Electronic Limited v. CDM Kabushiki Kaisha, 26 USPQ2d 1503 1505 (TTAB 1993). In both the *Commodore* and *Lane* cases, cited by Opposer, the Board denied summary judgment upon facts exactly like those alleged by the Opposer here.

The Opposer's moving papers are substantially composed of a listing of interrogatories and responses. The record filed under oath by the Opposer clearly establishes the *bona fide* nature of the Applicant's use of the DEXXON trademark. The DEXXON *bona fide* use is well documented and obviously not in dispute. Under the applicable standard for resolving summary judgment, all fact questions must be resolved in favor of the Applicant, as the non-moving party. The facts presented in Opposer's briefs establish, and for purposes of this motion are undisputed, that the Applicant's company specializes in storage media, and that the company's catalogs offer "a most extensive range of storage media and devices covering a very wide span of the market requirements from floppy discs and CDs addressing the home and desktop markets". It is undisputed that the company's geographical "situation" extends throughout European markets, and that the company has considerable sales and service capacity as well. Documents indicate that DEXXON is sold to resellers and not end users. This use obviously is not in dispute.

While summary judgment is not generally defeated by criticizing the moving party's evidence, Applicant has no reason to criticize. The Applicant does not

dispute the web information, which is precisely what the Applicant itself would file. Rather, the Applicant relies on this same evidence as clearly demonstrating Applicant's *bona fide* interest in the DEXXON trademark. Congress, in enacting a "*bona fide*" standard, sought to discourage creation of a market in trademarks where first to file would preempt or preclude a legitimate claim, much in the way cybersquatters would later learn to hijack words from their rightful owners. The *bona fide* standard was designed to insure that trademarks were not bought and sold in gross or filed with no underlying business rationale than to preclude others or ransom a mark to a rightful owner.

In this matter, the documentation supplied by Opposer's very own papers establish Applicant's large installed customer base in Europe. By inference, which must be resolved in favor of the Applicant, the reference to "our European customers base" clearly implies there are other customer bases as well. If Europe were the sole and only intended market, there would be no point in differentiating the "European" customer base (any more than a strictly American company would be likely to refer to its exclusively American consumers and customers as "our American customer base" rather than simply

the more commonly seen "our customer base"). That the extensive marketing materials and price listing do not specifically touch on the American market does nothing to remove the company's obvious desire (obvious if nothing else by its filing of this trademark application in 1998) to exploit the American market.¹

Tab E of Exhibit 1, relied upon by the Opposer, references again a statement by the Applicant that it does not *currently* (emphasis added) "sell used, modified or after market products in the United States". This certainly raises the factual presumption that it sells products other than those enumerated types.

Case law has clearly established in the above cited cases, and others, that *bona fide* intention is a question of fact which will be best determined at a trial on the merits. Here there is little reason to doubt the Applicant's *bona fide* intention to use this mark. The inferences are clear.

¹ The fact that efforts to expand use of the trademark in the United States, in view of the present opposition cannot in any reasonable sense be held against the company's prudent desire to resolve its trademark matters in the United States, and the opposer's objections, before taking further actions.

It would be hard to find a more logical business inference than the one at hand: The company is involved in sales and services in Europe; the company wishes to extend its activities to the American market; the company filed a trademark application claiming its *bona fide* intention to use the mark in commerce, relying, as is customary practice, upon its previously filed Benelux National registration.

DataWorx is a company with a substantial business under this mark, and which simply has a *bona fide* intention to use the mark in another marketplace. To the extent that the Opposer seeks to use discovery responses in support of its case, the example recited at the bottom of Opposer page 6 is illustrative:

Interrogatory No. 42 (Exhibit 1 at Tab E)

- State whether you sell or intend to sell any products for which the brand name of the product is DEXXON and if so, identify all such products.

“Applicant states that it does intend to sell products in the United States for which the brand name of the product is DEXXON, but it does not currently have plans regarding specific items.”

These very interrogatory responses on which the Opposer is relying state a proposition 180 degrees opposite that upon which the motion is premised. Namely, Applicant has a *bona fide* intention, which it restates here. Applicant has a large international business, conducted under the trademark which is the subject of this application. This is proven by all of the information of record already, so kindly supplied by the Opposer.

From an evidentiary standpoint, the applicant directs the Board's attention to the Opposer's selective and hence misleading quotation. For example, interrogatory response 42 (opp. Motion, page 5) was predicated upon numerous objections and the partial answer repeated by Opposer deleted not only the substance of the objection, but even the qualification that the response is only subject to the objection and without waiver. Hence, the response is not admissible for purposes of this motion.

Document request 24 is, similarly, subject to objection. Yet the response as argued in the brief selectively redacts such language, as well as the incorporated general objections, and indication that supplementation could be

forthcoming.

Plaintiff's citations in each and every document request and interrogatory, without a single exception, remove all reference to Applicant's often strenuous objection; the quoted responses are all made only subject to the objections. These objections cite a number of serious deficiencies with the discovery devices, including vagueness, irrelevance, over breadth, confidentiality, and other issues. Hence, from an evidentiary standpoint, Opposer seeks to rely on responses which, by their nature, cannot be construed in the light cast by Opposer.

Opposer has not, in its brief, recited a single disagreement to any objection asserted by the Applicant. Accordingly, Opposer, by having asserted the responses, has conceded the propriety of the objections for purposes of this motion, and may not now, later on rebuttal, try to cure by invoking a late challenge to the evidence it has itself introduced.

The purpose for permitting *bona fide* intention to use applications is to allow an applicant certainty in its business affairs. If an applicant were required to file an intent to use application, and then begin generating documents and materials in order to support that registration (particularly prior to receiving a Notice of Allowance) the underlying principals of this system would be defeated. Allowance has at least two steps: one is clearing examination by a trademark examining attorney, the second is clearing the publication process required under the statute. To try establishing a new rule of law which would seem to put a burden upon an applicant, without more, to generate materials in support of its use of a mark at any point prior to the statutory expiration of all available extension requests is at odds with the statute and its bases. Demonstrating that the Applicant has a legitimate business under the DEXXON mark for these and related services is enough. The application rules require that in order to obtain additional extensions of time to prove use beyond the first, statements must be submitted concerning the efforts made to accomplish such use. By implication, before that second extension request, there is no presumption that tangible evidence and the production of such evidence stands as any sort of requirement under Section 1(b) of the Trademark Act.

Opposer is misguided in trying to characterize what it says is “Applicant’s mere statement of subjective intention” to establish *bona fide* use. It is very difficult to say that there is a “mere intention” when the Applicant’s use is undisputedly voluminous with regard to the DEXXON trademark on an international basis. How any reasonable business person would be unable to understand the connection between the *bona fide* intention to use this mark as set forth in this application and, reviewed in light of its ongoing substantial business, is impossible to grasp.

In relying on these two prior cases, *Commodore* and *Lane*, both of which found insufficient grounds for summary disposition, Opposer clearly tips its hand. Its concluding argument that “Applicant has never used DEXXON as a trademark for goods” (emphasis added) is at the heart of its argument. Applicant struggles, however, to understand how actual use of the mark on particular goods relates to the statutory framework of intention to use. Respectfully, Opposer’s motion for summary judgment must be denied.

Respectfully submitted,



Jess M. Collen

COLLEN *IP*

The Holyoke-Manhattan Building

80 South Highland Avenue

Ossining, New York 10562

Tel. 914-941-5668

Attorney for Applicant

JMC:pm

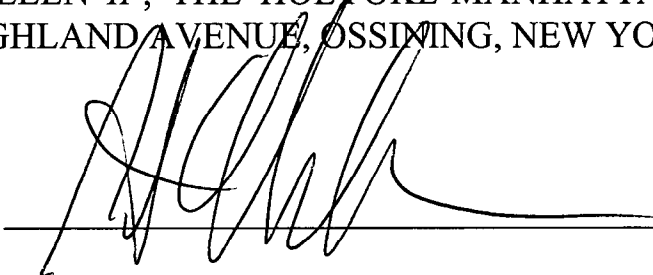
Enclosures - Certificate of Service
- Duplicate Copies

Dated: December 12, 2003

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND
TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH
FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: TRADEMARK TRIAL AND APPEAL BOARD, UNITED STATES PATENT AND TRADEMARK OFFICE, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202.

COLLEN *IP*, THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE, OSSINING, NEW YORK 10562

By:  Date: December 12, 2003

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CERTIFICATE OF SERVICE

I hereby certify that the

APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR

SUMMARY JUDGMENT

has been served upon Stephen P. Meleen, Esq., and Fulbright & Jaworski L.L.P., 600 Congress Avenue, Suite 2400, Austin, Texas 78701, by first class mail, postage prepaid, on December 12, 2003.



Peter E. Mulhern